



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/974,676

10/10/2001

Toshihiro Morita

275782US6

7507

22850

7590

11/12/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

LU, CHARLES EDWARD

ART UNIT

PAPER NUMBER

2161

NOTIFICATION DATE

DELIVERY MODE

11/12/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 09/974,676	Applicant(s) MORITA ET AL.	
	Examiner CHARLES E. LU	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/6/9; 5/26/9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to the Amendment dated 7/10/2009. Claims 2-22 are pending and rejected.

Response to Amendments/Response to Arguments

2. The 35 USC 101 rejection of claim 17 is withdrawn in view of the amendment.

Applicant's arguments regarding the prior 35 USC 103(a) rejection were fully considered. Applicant argues the claims as amended. As such, the prior grounds of 103 rejection are withdrawn. The new grounds of rejection below are necessitated by amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. New Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 20 and 22, it is unclear what is meant by the first limitation, "storing a plurality of content identifications that identify each content in a predetermined format that corresponds with one of the plurality of content identifications." The language, sentence structure and/or the antecedent basis is/are unclear.

Claim 21 depends from a rejected parent claim.

The broadest reasonable interpretation has been applied to the claims.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 2-5, 8-13, 16-20 and 22 are rejected under 35 USC 103(a) as being unpatentable over Wiser et al. (U.S. 6,385,596) hereinafter “Wiser,” in view of Sahai et al. (U.S. Patent 6,594,699), hereinafter “Sahai.”

As to claim 9, Wiser teaches the following claimed subject matter:

A record controlling step for controlling a record in which first data identifies a predetermined content (e.g., col. 14, ll. 40-48),

A specifying step for specifying from a content list the predetermined content on the basis of the first data which represents the predetermined content in the content list (e.g., col. 14, ll. 40-48, fig. 8 preview).

Wiser does not expressly teach:

(1) second data identifies a first file of the predetermined content stored in a first format, third data identifying a second file of the predetermined content stored in a second format, said first, second, and third data all corresponding to the predetermined content.

(2) selecting step for selecting either the first or second file in association with the predetermined content specified in the specifying step

Art Unit: 2161

(3) manipulating step for manipulating the first or second file on the basis of the second data or the third data in association with either the first or second file, by controlling an encoding bit rate for the first file or second file, whichever has been selected.

However, Sahai teaches or suggests (1) second data identifies a first file of the predetermined content stored in a first format (e.g., col. 6, l. 19, MPEG1 format of file), third data identifying a second file of the predetermined content stored in a second format (e.g., col. 6, l. 19, MPEG2 format of file), said first, second, and third data all corresponding to the predetermined content (e.g., URL, and different file formats all correspond to a given video clip). Moreover, Wiser teaches a URL corresponding to multimedia content.

Sahai further teaches or suggests (2) selecting step for selecting either the first or second file in association with the predetermined content specified in the specifying step (col. 6, ll. 12-20, first or second file is selected based on client capability).

Sahai further teaches or suggests (3) manipulating step for manipulating the first or second file on the basis of the second data or the third data in association with either the first or second file, by controlling an encoding bit rate for the first file or second file, whichever has been selected (e.g., col. 6, ll. 34-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiser, to support (1)-(3), namely, storage, retrieval, and streaming a chosen format of a given media asset based on client capabilities, and adjustment of the encoding bit rate, as claimed. The motivation would

Art Unit: 2161

have been to create an intelligent server system that adapts to the capability of the client, for intelligent data transfer, as taught by Sahai (e.g., col. 1, l. 55 - col. 2, l. 35).

As to claim 10, the combination as applied above further teaches wherein the manipulating step reproduces the predetermined content stored in either the first or second file (e.g., Sahai, streaming content in the chosen file format to the client).

As to claim 11, the combination as applied above further teaches wherein the selecting step further selects the manipulating step in accordance with the format of either the first or second file, whichever has been selected (e.g., Sahai selecting a format of the file and the bit rate).

As to claim 12, the combination as applied above further teaches wherein the manipulating step transfers either the first or second file (e.g., Sahai streaming to the client).

As to claim 13, the combination as applied above further teaches wherein the selecting step selects the manipulating step in accordance with a setting (e.g., Sahai using the client capability to select a file).

As to claim 16, the combination as applied above teaches a first and second media file, but does not expressly teach deleting either the first or second file.

However, Wiser teaches deleting a media data file (e.g., col. 20, ll. 57-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiser and Sahai, such that either the first or second media file can be deleted. The motivation would have been to save storage

Art Unit: 2161

space, especially if the file is no longer needed by the system, as known to one of ordinary skill in the art.

Claim 17 is rejected based on the same reasons as claim 9, discussed above.

As to claim 18, Wiser teaches:

A storage unit configured to store a plurality of contents in a storage area of a memory (e.g., fig. 1B, #124, col. 14, ll. 54-56);

A content ID specifying unit configured to specify a content ID of the predetermined content when the predetermined content is selected from a content list, wherein the content ID represents the predetermined content in the content list (e.g., col. 14, ll. 40-48, fig. 8 preview);

Wiser does not expressly teach:

(1) a database in which a first file ID identifying a first file of a predetermined content stored in a first format and a second file ID identifying a second file of the predetermined content stored in a second format that may be associated with a content ID that identifies the predetermined content;

(2) a selecting unit configured to select one of the first file and the second file based on the first file ID and the second file ID acquired from the database when the content ID specified by the content ID specifying unit is associated with the first file ID and the second file ID; and

(3) a manipulating unit configured to manipulate the first file or the second file, by controlling via an encoder an encoding bit rate for the first file or the second file, whichever has been selected.

However, Sahai teaches or suggests (1) because Sahai stores different formats of a given file, and retrieves a chosen format of the file based on the client's capabilities (e.g., col. 6, ll. 12-20). There should be a first and second file ID associated with a content ID, as claimed, to facilitate data identification and access. Moreover, Wiser discloses a content ID (e.g., col. 14, ll. 40-48, fig. 8 preview).

Sahai further teaches or suggests (2) because a file in a given format is chosen based on the client's request and the client's capability. The selection should be based on the first and second file ID's and the content ID, to facilitate data access, as claimed. Moreover, Wiser discloses a content ID (e.g., col. 14, ll. 40-48, fig. 8 preview).

Sahai further teaches or suggests (3) manipulating unit for manipulating the first or second file by controlling via an encoder an encoding bit rate for the first file or second file, whichever has been selected (e.g., col. 6, ll. 34-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiser, to support (1)-(3), namely, storage, retrieval, and streaming a chosen format of a given media asset based on client capabilities and file ID's, and adjustment of the encoding bit rate, as claimed. The motivation would have been to create an intelligent server system that adapts to the capability of the client, for intelligent data transfer, as taught by Sahai (e.g., col. 1, l. 55 - col. 2, l. 35). The motivation for using file ID's and content ID's would have been to facilitate data identification within a computing system, as known to one of ordinary skill in the art.

As to claim 19, the combination as applied above further teaches a transmitting unit configured to transmit the predetermined content selected from the content list to other apparatus (e.g., Sahai transmitting a video clip of a specified format to the client);

Wherein the selecting unit selects the first or second file according to the format supported by the other apparatus (e.g., Sahai's file format is determined based on client's capability).

Claims 2-5 and 8 are rejected based on the same reasoning as the above claims.

As to claim 20, Wiser teaches a storing unit to store a plurality of content identifications identifying each content in a predetermined format that corresponds with one of the plurality of content identifications (e.g., col. 14, ll. 40-60, fig. 1B, #124; media file must have a format);

A display unit configured to display the plurality of content identifications (e.g., fig. 8);

A select unit configured to select a predetermined content identification by selecting one of the plurality of content identifications displayed on the display unit (e.g., fig. 8, selected music to preview);

Wiser does not expressly teach (1) an acquisition unit configured to acquire a format from an information processing apparatus and operable to operate a predetermined content file identified by the predetermined content identification in the information processing apparatus, and a transfer unit configured to transfer the predetermined content file specified by the predetermined content identification selected

Art Unit: 2161

by the select unit in accordance with the format acquired by the acquisition unit to the information processing apparatus.

However, Sahai teaches or suggests (1) because Sahai supports, given a client selection of a media asset, surveying the client for client capabilities and selecting an appropriate file format based on the client capability. Then, the appropriate file is sent to the client at a specified bit rate (e.g., col. 6, ll. 12-42). As discussed above, Wiser supports a content ID.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiser, such that (1) above is implemented to transfer the appropriate file format to the client based on the client capability. The motivation would have been to create an intelligent server system that adapts to the capability of the client, for intelligent data transfer, as taught by Sahai (e.g., col. 1, l. 55 - col. 2, l. 35).

Wiser and Sahai do not expressly teach “another information processing apparatus.”

However, an information processing apparatus above can be understood to be a client computer. Sahai gathers information from a client computer to determine a format. Wiser operates with any number of client systems (e.g., col. 5, ll. 46-48). Thus, the prior art suggests “another” information processing apparatus.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiser and Sahai, such that another information processing apparatus is implemented. The motivation would have been to support data

Art Unit: 2161

communication among several systems, and more fully utilize a network, as known to one of ordinary skill in the art.

Claim 22 is rejected based on the same reasoning as claim 20.

5. Claims 6, 7, 14, 15, and 21 are rejected under 35 USC 103(a) as being unpatentable over Wiser, in view of Sahai, and further in view of Putz et al. (5,210,824), hereinafter “Putz.”

As to claim 14, Wiser and Sahai as applied above teach predetermined content, formats and files, but do not expressly teach generating the predetermined content in the second format on the basis of the first file.

However, Putz teaches converting a given file from one format to another (e.g., col. 17, ll. 32-51). The converted data is stored as a file (e.g., col. 17, ll. 40-50). Thus, Putz suggests generating a predetermined content in a second format based on a first file, as claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiser and Sahai, such that the second format file can be generated by converting the first file to the second file. This would meet the claimed subject matter. The motivation would have been to facilitate conversion and storage of different format files, so that the files can be used by clients requiring different formats, as known to one of ordinary skill in the art and taught by Putz (e.g., Abstract).

Art Unit: 2161

As to claim 15, Wiser and Sahai as applied above teach a first file and second file, but do not expressly teach converting either the first or second file to a third file for storing the predetermined content in a third format.

However, Putz teaches converting a given file from one format to another (e.g., col. 17, ll. 32-51). The converted data is stored as a file (e.g., col. 17, ll. 40-50). The given file can correspond to one of the file formats taught by Sahai. Thus, Putz suggests converting the first or second file to a third file for storage in a third format, as claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiser and Sahai, such that a third format file can be generated by converting the first or second file, as claimed. The motivation would have been to provide support for more types of clients and client capabilities in reading files, as known to one of ordinary skill in the art.

Claims 6 and 7 are rejected based on the same reasoning as the above claims.

As to claim 21, Wiser and Sahai as applied above teach or suggest all the claimed subject matter except for a conversion unit to convert the file.

However, Putz teaches converting a given file from one format to another (e.g., col. 17, ll. 32-51). The converted data is stored as a file (e.g., col. 17, ll. 40-50). When combined with Wiser and Sahai, the converted file can be transferred to the client, as claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wiser and Sahai, such that a converter would be

Art Unit: 2161

implemented to convert a file into a desired format to be transferred to the client. This would meet the claimed subject matter. The motivation would have been to facilitate conversion and storage of different format files, so that the files can be used by clients requiring different formats, as known to one of ordinary skill in the art and taught by Putz (e.g., Abstract).

Conclusion

6. Applicant's amendment necessitates new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Lu whose telephone number is (571) 272-8594. The examiner can normally be reached on 8:30 - 5:00; M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached at (571) 272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Charles E Lu/
Examiner, Art Unit 2161
11/9/2009

/Apu M Mofiz/
Supervisory Patent Examiner, Art Unit 2161